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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,729	09/28/1999	IN TAE HWANG	CIT/K-090	1898
34610	7590	03/21/2006	EXAMINER	
FLESHNER & KIM, LLP P.O. BOX 221200 CHANTILLY, VA 20153			ELALLAM, AHMED	
			ART UNIT	PAPER NUMBER
			2616	
DATE MAILED: 03/21/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

6) ✓

<b>Office Action Summary</b>	<b>Application No.</b> 09/406,729	<b>Applicant(s)</b> HWANG ET AL.	
	<b>Examiner</b> AHMED ELALLAM	<b>Art Unit</b> 2668	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13, 34-47, 49-60, 63 and 64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 34-47, 49-60, 63 and 64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

This office action is responsive to RCE filed on 01/11/2006.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-13 and 34-47, 49-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.
2. Claims 1 and 10 both recite selecting the transport format according to the decided bearer service profile type. However, the specification does not adequately describe how such a selection is made, such that a skilled artisan could make and use the claimed invention. Namely, the specification does not show any correlation between the decided bearer service profile type and how it is used to select the transport format. For example, which transport format is used when the bearer service is speech? Which transport format is selected when the bearer service is packet switched data?

3. Claims 34 and 58 recite determining the transport format combination set according to the type of wireless service and the radio environment measurement. However, the specification does not adequately describe how such a determination is made, such that a skilled artisan could make and use the claimed invention. Specifically, the specification does not draw any correlation between what a particular wireless service and environment measurement are and how they correspond to a determined particular transport format combination set to be used. For example, if the wireless service is speech service and the environmental measurement indicates the radio is in a vehicle, what would be the corresponding transport format combination set?
4. Claims 63 recite selecting the transport format for each transport channel based on the transport format combination set. The specification does not adequately describe how such a selection is made, such that a skilled artisan could make and use the claimed invention. Namely, the specification does not describe how a specific format is selected based on a format combination set.
5. Claim 64 recites determining a service profile type based on at least one of a bearer service type or a bearer service class type, and establishing at least one radio access bearer based on the service profile type. However, the specification does not adequately describe how such a determination is made, such that a skilled artisan could make and use the claimed invention. Specifically, the specification does not draw any correlation between a bearer service type or a bearer service class type and the establishment of a radio bearer based on the service profile type. For example, what

distinguishes between the radio access bearers when established based on respective different bearer service types or bearer service class type?

Claims 2-9,11-13,35-57, 59 and 60 are rejected because they depend on rejected base claims.

6. Claims 63 and 64 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As to claim 63, the specification as originally filed doesn't describe the limitation "assigning a transport format combination set based on at least one bearer service type or a bearer service class". In particular the specification does not describe **one of** bearer service type **or** a bearer service class for the assigning of a transport format combination set. The transport format combination set as best understood is based on both bearer service type and bearer service class.

As to claim 64, the specification as originally filed doesn't describe the limitation "determining a service profile type based on at least one of a bearer service type or a bearer service class type" In particular the specification does not describe **one of** bearer service type **or** a bearer service class type for the determination of a service profile type. The service profile type as best understood is based on both bearer service type and bearer service class type.

***Response to Arguments***

7. Applicant's arguments filed 01/11/2006 have been fully considered but they are not persuasive:

Applicants' argument with reference to the 112 1<sup>st</sup> rejections of pending claims 1-13, 34-47, 49-60,63 and 64 is not persuasive.

Applicants cited several case laws related to 35 U.S112 1<sup>st</sup> Paragraph, but they failed to point to one single embodiment in the specification showing an example of how the invention actually works.

As to the declaration under 37 C.F.R 1.132 , Affiant provided tables A1-A4 and table 5, however the provided tables may in no way be derived from what originally described in the specification. Affiant didn't address the specification and how these tables can be derived from it.

In addition to the above, Examiner noted that Applicants fail to point where supportive evidence for at least one single embodiment in the specification using the appendixes A through G.

Equally important, Appendix A has illegible text, see for example pages 197-244.

Appendix D have a date after the priority date, see for example page 14 which indicate a date of 18 January 99, which is after the priority date of the application.

Given the above, Examiner maintains the rejections above of being proper.


**Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AHMED ELALLAM whose telephone number is (571) 272-3097. The examiner can normally be reached on 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kizou Hassan can be reached on (571) 272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AHMED ELALLAM  
Examiner  
Art Unit 2668  
3/15/06



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